

REMARKS/DISCUSSION:

This Response E is being filed within the shortened period for response that ends on April 7, 2011. It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents or the electronic filing accompanying this Response B. However, if additional extensions of time are necessary to prevent abandonment of the above-referenced application, then such extensions of time are hereby petitioned under 37 C.F.R. 1.136(a), and any fees required there for (including fees for filing and net addition of claims) are hereby authorized to be charged to the Deposit Account No. noted below.

By this Response E, claims 1-3, 5-8, 10-14 and 16-21 are pending in this application. Claims 1, 5, 7, 16, 20 and 21 have been amended. Claim 4 has been canceled. Support for the amendments to claims 1, 16 and 21 can be found at least at Fig. 1 and support for claims 5 and 20 can be found at least at ¶ [0007].

Amendment and/or cancellation of claims are not to be construed as a dedication to the public of any of the subject matter of the claims previously presented. Further, any amendments or arguments are made without conceding the correctness of any of the rejections of the pending Office Action, and Applicant(s) reserves the right to prosecute the subject matter of such claims in continuation and/or divisional applications.

Applicant has carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

A. Rejection under 35 U.S.C. § 103(a)

Claims 1-8, 10-14 and 16-21 stand rejected as being unpatentable over U.S. Patent No. 5,275,607 to Lo in view of Schwemberger, U.S. Patent No. 6,589,200 as noted in the Office Action.

To establish a *prima facie* case for obviousness, the Office must properly ascertain the differences between the prior art and the claimed invention. MPEP § 2141; *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In ascertaining those differences, the Office must

make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." *In re Wada and Murphy*, Appeal 2007-3733, slip op. at p. 7 (BPAI, January 14, 2008) (quoting *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)) (emphasis in original). The Office must then support a conclusion of obviousness by providing specific reasoning explaining "why every limitation in [the rejected claim] would have been obvious to a person of ordinary skill in the art." *Id.* at pp. 7-8 (emphasis added).

Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because of non-obvious patentable differences between the cited references and the rejected claims. More particularly, Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness.

*1. There is no motivation to combine Lo with Schwemberger*¹

A person of ordinary skill in the art related to ultrasonic medical devices would not lead to the combination of the Lo and Schwemberger references to devise the surgical instrument of claim 1. The Office must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. *See* 72 Fed. Reg. 57526 at 57528-29. A person of ordinary skill in the art of ultrasonic medical devices would not be lead to review references related to non-ultrasonic, low frequency of operation medical devices to improve at ultrasonic, high frequency medical instrument. At page 3, last paragraph, in support of the obviousness rejection, the Office Action proffers the following statement:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Lo with the ultrasonic waveguide as taught by Schwemberger for safe and effective treatment of medical conditions.

This is clearly a conclusory statement. A conclusion of obviousness must be supported with some articulated reasoning with some rational underpinning; mere conclusory statements are not sufficient. *See id.* The reasoning provided by the Office is not related to any reason for using the teachings of a motor-driven blade at frequencies from 500-800

¹ Applicants maintain all arguments from previous Responses.

Hz (see, 14:7, 15: 44-46) combined with the teachings of an ultrasonic instrument that operates at tens of thousands Hz (see, 3: 34-36).

In fact, Lo teaches away from the combination suggested by the examiner. Lo consistently teaches low frequencies (as compared to ultrasonic frequencies). See, for example, 5: 40-47 and 6: 51-62. Lo specifically states that lower frequencies are required and higher frequencies would produce unwanted results.

it is caught between closed scissor blades. Another consideration, for a commercially desirable intraocular instrument such as a scissors using a reciprocating solenoid, is that the reciprocation does not induce a positive pressure that would blow air into the eye; and, on the other hand, does not produce a vacuum that would suck tissue into the hollow needle in the space between the blade and the surrounding annular wall of the needle.

7: 24-32.

This teaching in Lo is contra to the teachings of the present invention. See ¶[0007] in the instant application. Therefore, one skilled in the ultrasonic arts for medical devices would not look to Schwemberger to modify Lo. Clearly, the Office has not met their burden here.

Accordingly, in view of the foregoing amendments and remarks, Applicant respectfully submits that Lo and Schwemberger, whether taken alone or in combination, fail to disclose every element recited in independent claims 1, 16 and 21. At least on the basis the dependency from claims 1 and 16, Applicant respectfully submits that claims 2, 3, 5-8, 10-14 and 17-20 also are non-obvious and patentable over Lo in view of Schwemberger, whether taken alone or in combination. Accordingly, Applicant respectfully requests withdrawal of the obviousness rejection with respect to the claims.

Applicants further note that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness. For example, and not by limitation, claims 6-8 recite placement of the lumen adjacent a node. Lo neither discloses nor suggests a node or placement of the lumen adjacent a node. The examiner incorrectly cites Lo has disclosing "the lumen is

fixed or moveable to a position adjacent to the transverse or torsional *node* to facilitate suction C5 L40-55.” *Emphasis* added.²

A reading of the cited disclosure provides no hint that a lumen is fixed or moveable adjacent a transverse or torsional node. Further, Lo neither discloses nor suggests any reference to a placement of anything, let alone a lumen, adjacent to a node. This is understandable since Lo does not teach, and teaches away from ultrasonic energy which transmits by way of a standing wave and defines nodes and anti-nodes. See, for example, ¶[0030] of the instant application.

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² The examiner is respectfully cautioned to distinguish “mode” from “node”.

Conclusion

Applicant submits that in view of the discussion, the rejections under 35 U.S.C. § 103(a) have been overcome and that the invention is now patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, which may be required to Account No. 10-0750/END0797USNP/VEK.

Respectfully submitted,

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